

Rec'd PCT/PTO 12 JUN 2002 #10

Attorney Docket: FJIN-107

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : GOTO et al.  
Serial No. : 09/787,397 Group Art Unit: Not yet assigned  
Int Filing Date: September 17, 1999 Examiner: Not yet assigned  
Title : PREVENTIVE AND/OR THERAPEUTIC FOR OBESITY

**RESPONSE TO NOTIFICATION OF DEFECTIVE RESPONSE**

Box PCT  
Assistant Commissioner for Patents  
Washington, DC 20231

Sir:

This is responsive to the Notification of Defective Response dated May 22, 2002.  
Applicants respectfully maintain that this Notification was mailed in error.

Applicants filed (1) a Second Preliminary Amendment; (2) Statement Regarding Sameness and New Matter With Regards to the CRF and the Second Substitute Sequence Listing, and (3) a Computer Diskette on May 17, 2001 in Response to the Notification of Missing Requirements dated May 4, 2001.

In a June 4, 2002 telephone conference with Mr. Mark Spencer, Applicants' representative was informed that these documents filed on May 17, 2001 via Express Mail were never forwarded to the Biotechnology Systems Branch of the Scientific and Technical Information Center. As requested by Mr. Spencer, copies of the Second Preliminary Amendment, Second Substitute Sequence Listing, and Computer Diskette are attached hereto. Also enclosed is a copy of the stamped PTO postcard.

The Second Preliminary Amendment and Second Substitute Sequence Listing fully complied with 37 CFR 1.823. In particular, the source of genetic material for SEQ. ID

GOTO et al. - Serial No. 09/787,397  
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NO. 1 and SEQ. ID NO. 2 was explained in each respective numeric identifier <223>. Because the genetic material is an artificial sequence, only <223> must be completed. According to 37 CR 1.823 and MPEP 2424 to MPEP 2424.02, numeric identifiers <221> and <222> are not mandatory.

A copy of the Notification of Defective Response is enclosed.

If any fee is due, please charge our Deposit Account No. 501032 (Docket No. FJIN-107).

Respectfully submitted,



Warren A. Zitlau  
Registration No. 39,085

Barry I. Hollander  
Registration No. 28,566

Hollander Law Firm, P.L.C.  
Suite 305, 10300 Eaton Place  
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Fax: (703) 383-4804

June 12, 2002

Enclosures: Copy of Stamped PTO postcard  
Copy of May 17, 2001 Statement Regarding Sameness and New Matter  
With Regards to the CRF and the Second Substitute Sequence  
Listing with copies of its enclosures (Substitute Sequence Listing  
(3 pages), diskette package label, and Diskette of Substitute  
Sequence Listing  
Copy of May 17, 2001 Second Preliminary Amendment  
Copy of Notification of Defective Response

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

500

Applicants : GOTO et al.  
Serial No. : 09/787,397 Group Art Unit: Not yet assigned.  
Filing Date : September 17, 1999 Examiner: Not yet assigned.  
For : PREVENTIVE AND/OR THERAPEUTIC FOR OBESITY

EXPRESS MAIL CERTIFICATE

Date JUNE 12, 2002 Label No. EU 158803159 US

I hereby certify that, on the date indicated above, I deposited this paper and accompanying papers and fee with the U. S. Postal Service and that it was addressed to Box PCT, Assistant Commissioner for Patents, Washington, D. C. 20231, by "Express Mail Post Office To Addressee" service.

Phyllis D. Caldwell  
Name (Print)

Phyllis D. Caldwell  
Signature

Comr. of Patents & Trademarks  
Washington, DC 20231

BIH 5/17/01

Sir: By placing your receiving stamp hereon & mailing, kindly  
acknowledge receipt of:

GOTO et al - Serial No. 09/787,397 - Transmittal Letter to the U. S.  
Designated/Elected Office Concerning A Filing Under 35 U.S.C. 371 (second  
submission), executed Declaration, Recordation Form Cover Sheet,  
assignment, \$170.00 for filing & recordal fees, Eng. translation of Japanese  
#263004/1998, copy of Notification of Missing Requirements, Second  
Preliminary Amendment, 2<sup>nd</sup> Substitute Sequence Listing, Computer Diskette  
of 2<sup>nd</sup> Substitute Sequence Listing, Statement regarding Sameness and New  
Matter w/Regards to the CRF & the 2nd Substitute Sequence Listing, via  
Express Mail on May 17, 2001, Express Mail No. EK 72915307265  
due 7/4/01  
FJIN-107

JC17 Rec'd PCT/PTO 17 MAY 2001



## UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patent and Trademark  
United States Patent and Trademark Office  
Washington, D.C. 20231  
www.uspto.gov

U.S. APPLICATION NO.	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
09/787397	GOTO M	FJIN-107
INTERNATIONAL APPLICATION NO.		
PCT/JP99/05080		

BARRY I HOLLANDER  
HOLLANDER LAW FIRM  
SUITE 305 10300 EATON PLACE  
FAIRFAX, VA 22030

RECEIVED

MAY 05 2001

HOLLANDER LAW FIRM, P.L.C.

I.A. FILING DATE	PRIORITY DATE
17 SEP 99	17 SEP 98

DATE MAILED:

04 MAY 2001

**NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)**

1. The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as ☐ a Designated Office (37 CFR 1.494) ☒ an Elected Office (37 CFR 1.495):

- |  |  |
|--|--|
| <input checked="" type="checkbox"/> U.S. Basic National Fee.   | <input type="checkbox"/> Indication of Small Entity Status.                                    |
| <input checked="" type="checkbox"/> Copy of the international application.   | <input checked="" type="checkbox"/> Translation of the international application into English. |
| <input checked="" type="checkbox"/> Oath or Declaration of inventors(s).   | <input type="checkbox"/> Translation of Article 19 amendments into English.                    |
| <input type="checkbox"/> Copy of Article 19 amendments.  | <input type="checkbox"/> Other:  |
| <input checked="" type="checkbox"/> Priority Document.   |  |
| <input checked="" type="checkbox"/> The International Preliminary Examination Report in English and its Annexes, if any. |  |
| <input type="checkbox"/> Translation of Annexes to the International Preliminary Examination Report into English.        |  |

DOCKETED

Docket No. FJIN-107

Response Due: 7/4/01

2. ☐ Applicant has requested early processing under 35 U.S.C. 371(f) but has not filed the following indicated items and/or the indicated items in paragraph 3 below. The Basic National Fee and the copy of the international application must be filed prior to 20 or 30 months from the priority date to avoid abandonment.

- ☐ U.S. Basic National Fee. ☐ Copy of the international application.

3. The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

- ☐ a. Translation of the application into English. A processing fee will be required if submitted later than the appropriate 20 or 30 months from the priority date.
- ☐ The current translation is defective for the reasons indicated on the attached Notice of Defective Translation.
- ☐ b. Processing fee for providing the translation of the application and/or the Annexes later than the appropriate 20 or 30 months from the priority date (37 CFR 1.492(f)).
- ☒ c. Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), properly identifying the application (preferably by the International application number and international filing date). A surcharge will be required if submitted later than the appropriate 20 or 30 months from the priority date.
- ☒ The current oath or declaration does not comply with 37 CFR 1.497(a) and (b) for the reasons indicated on the attached PCT/DO/EO/917.
- ☒ d. Surcharge for providing the oath or declaration later than the appropriate 20 or 30 months from the priority date (37 CFR 1.492(e)).

4. Additional claim fees of \$ \_\_\_\_\_ as a ☐ large entity ☐ small entity, including any required multiple dependent claim fee, are required. Applicant must submit the additional claim fees or cancel the additional claims for which fees are due (37 CFR 1.492(g)). See attached PTO-875.

5. ☒ Applicant has not submitted the required sequence listing pursuant to 37 CFR 1.821-1.825. See attached PCT/DO/EO/920.

**ALL OF THE ITEMS SET FORTH IN 3(a)-3(d), 4 AND 5 ABOVE MUST BE SUBMITTED WITHIN TWO (2) MONTHS FROM THE DATE OF THIS NOTICE OR BY 22 OR 32 MONTHS (where 37 CFR 1.495 applies) FROM THE PRIORITY DATE FOR THE APPLICATION, WHICHEVER IS LATER. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.**

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

6. If box 3a or 3c is checked, a translation of the Annexes **MUST** be submitted no later than the time period set above or the Annexes will be cancelled. A processing fee will be required if submitted later than 20 or 30 months from the priority date.
7. ☐ The Article 19 amendments are cancelled since a translation was not provided by the appropriate 20 (37 CFR 1.494(d)) or 30 (37 CFR 1.495(d)) months from the priority date.

Applicant is reminded that any communication to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above. (37 CFR 1.5)

**A copy of this notice MUST be returned with this response.**

- Enclosed: ☒ PCT/DO/EO/917 ☐ Notice of Defective Translation  
☒ PTO-875 ☒ PCT/DO/EO/920

Barbara A. Campbell

FORM PCT/DO/EO/905 (March 2001)

Telephone: 703-305-3631



UNITED STATES PATENT AND TRADEMARK OFFICE

 Commissioner for Patents, Box PCT  
 United States Patent and Trademark Office  
 Washington, D.C. 20231  
 www.uspto.gov

U.S. APPLICATION NUMBER NO.	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
09/787,397	Masaaki Goto	FJIN-107

RECEIVED

MAY 27 2002

 Barry I Hollander  
 10300 Easton Place Suite 305  
 Fairfax, VA 22030

HOLLANDER LAW FIRM, P.L.C.

INTERNATIONAL APPLICATION NO.

PCT/JP99/05080

I.A. FILING DATE

PRIORITY DATE

09/17/1999

09/17/1998

CONFIRMATION NO. 2388

371 FORMALITIES LETTER



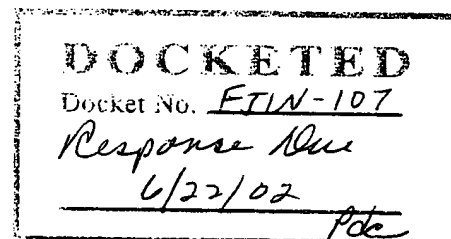
\*OC000000008166363\*

Date Mailed: 05/22/2002

## NOTIFICATION OF DEFECTIVE RESPONSE

The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as an Elected Office (37 CFR 1.495):

- U.S. Basic National Fee
- Priority Document
- Biochemical Sequence Diskette
- Biochemical Sequence Listing
- Copy of IPE Report
- Copy of references cited in ISR
- Copy of the International Application
- Copy of the International Search Report
- Information Disclosure Statements
- Oath or Declaration
- Preliminary Amendments
- Request for Immediate Examination



The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

**Applicant is required to complete the response within a time limit of ONE MONTH from the date of this Notification or within the time remaining in the response set forth in the Notification of Missing Requirements, whichever is the longer. No extension of this time limit may be granted under 37 CFR 1.136, but the period for response set in the Notification of Missing Requirements may be extended under 37 CFR 1.136(a).**

The following items **MUST** be furnished within the period set forth below:

- The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 CFR 1.821-1.825 for the following reason(s):

- See attached Raw Sequence Listing Error Report.

## ■ APPLICANT MUST PROVIDE:

- An initial or substitute paper copy or compact disc of the "Sequence Listing," as well as an amendment directing its entry into the specification.
- A statement that the contents of the paper or compact disc and the computer readable form are the same and, where applicable, include no new matter, as required by 37 CFR 1.821(e), 1.821(f), 1.821(g), 1.825(b) or 1.825(d).

- For questions regarding compliance to 37 CFR 1.821-1.825 requirements, please contact:

- For Rules Interpretation, call (703) 308-4216
- To Purchase PatentIn Software, call (703) 306-2600
- For PatentIn Software Program Help, call (703) 306-4119 or e-mail at [patin21help@uspto.gov](mailto:patin21help@uspto.gov) or [patin3help@uspto.gov](mailto:patin3help@uspto.gov)

Applicant is reminded that any communications to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above (37 CFR 1.5)

*A copy of this notice **MUST** be returned with the response.*

BARBARA A CAMPBELL

Telephone: (703) 305-3631

PART 1 - ATTORNEY/APPLICANT COPY

U.S. APPLICATION NUMBER NO.	INTERNATIONAL APPLICATION NO.	ATTY. DOCKET NO.
09/787,397	PCT/JP99/05080	FJIN-107

FORM PCT/DO/EO/916 (371 Formalities Notice)